



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:) HEADWEAR PIECE WITH
ROBERT KRONENBERGER) SELECTIVELY VIEWABLE
) ORNAMENTATION
Ser. No.: 10/721,135) Group Art Unit: 3765
)
Filed: 11/25/03) Examiner: Andrew W. Sutton

APPELLANT'S BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

Real Party in Interest

The real party in interest is Robert Kronenberger, the sole inventor.

Related Appeals and Interferences

There are no other prior or pending appeals, interferences, or judicial proceedings known to Appellant or the Appellant's legal representative which may be related to, directly effect or be directly effected by or have a bearing, on the Board's decision in the pending appeal.

37 CFR 1.8
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on 12-28-07 (date).

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Status of Claims

Claims 1-3 and 5-21 are currently pending. All claims stand rejected. The rejection of all claims 1-3 and 5-21 is being appealed.

Status of Amendments

No amendments have been made following the close of prosecution.

Summary of Claimed Subject Matter

The subject matter of the single independent claim, claim 1, is a headwear piece 10 with a crown 12 for embracing a wearer's head so as to maintain the headwear piece in an operative position thereon (see Fig. 2 and Specification page 8, lines 7-14). A brim/bill 32 projects forwardly from the crown 12 to produce a baseball-style cap configuration (see Figs. 1 and 2 and Specification page 8, lines 17 and 18).

The invention is concerned with the placement of specifically identified, different, information strategically at specific locations on the headwear piece 10. For purposes of designating locations on the crown, the crown is characterized as being divided into eight "octants" 38, 40, 42, 44, 46, 48, 50, 52 (see Fig. 5 and Specification page 9, lines 3-7).

First information, identifying an event, is provided on at least one of the front/left side and front/right side octants 46, 38 so as to reside at the front of the headwear piece 10 and thereby be plainly viewable from an elevated front perspective (See Figs. 5 and 6 and Specification page 9, line 15 through page 10, line 3).

Second information 56, identifying a plurality of participants in the event (the event as identified by the first information), is provided on at least one of: a) the right side/front

octant 40; b) the right side/rear octant); c) the rear/right side octant 44; d) the left side/front octant 48; e) the left side/rear octant 50; and f) the rear/left side octant 52 (see Figs. 5 and 6 and Specification page 10, lines 4-12).

The above subject matter can be understood more clearly with respect to one example with specific, exemplary types of the first and second information. The headwear piece can be used at an all star event, with the first information related to the identity of the all star game and the second information related to the identity of teams in the league that are participants in the all star game.

The headwear piece can be worn by players in conventional manner during the game. The first information will be plainly visible from a front elevation view to satisfy the identify needs for promoters of the all star game, in the same way that team logos and identities are visible when placed at the same location with conventional team caps.

The second information, by reason of its location, rearwardly and to the side of the first information, is not plainly visible, and does not lessen the prominence of the first information, from a front perspective from which most players will be viewed before, during and after a competition.

Thus, the headwear piece can be used by players during a game to function as a traditional headwear piece. The second information appeals to souvenir collectors and fans that can purchase and view the entirety of the headwear piece from different perspectives to be reminded of the participants in the game, thereby having an informative memento that is potentially identical to what was worn by the players during the game.

Issues to be Reviewed in Appeal

Issue No. 1

Whether claims 1-3, 5-9 and 11-18 are obvious under 35 USC §103 over U.S. Patent No. 6,175,963 (Loeffelholz) in view of U.S. Patent No. 6,370,696 (Kronenberger).

Issue No. 2

Whether claims 19-21 are obvious under 35 USC §103 over Loeffelholz in view of Kronenberger, and further in view of U.S. Patent No. 5,584,076 (Armstrong).

Issue No. 3

Whether the existence of a copy of the claimed hat, referenced by the Examiner in the May 17, 2006 Action, supports patentability?

Issue No. 1 - Claim 1

The last two limitations in claim 1 are what distinguish the invention from a conventional-style baseball cap, standing alone. More specifically, claim 1 recites first information identifying an event on at least one of the front/left side and front/right side octants; and second information identifying a plurality of participants in the event on at least one of a) the right side/front octant; b) the right side/rear octant); c) the rear/right side octant; d) the left side/front octant; e) the left side/rear octant; and f) the rear/left side octant.

Loeffelholz is relied upon by the Examiner for the disclosure of the basic components of a baseball-style cap, which hat style is admittedly well known.

Kronenberger is relied upon for the disclosure of different designs on a baseball-style cap which the Examiner claims on page 3 of the Final Action would make obvious to one of ordinary skill in the art the placement of the first and second information as claimed.

The Examiner further alleges, in the paragraph bridging pages 3 and 4 of the Final Action, that the information claimed "provides no structure to the cap that is not shown in the prior art [sic] are mere design choices". In the same paragraph, the Examiner asserts that the information amounts to ornamentation that has "no mechanical function" to patentably distinguish over the prior art. The Examiner concludes in this paragraph that "the Applicants' [sic] claims no structural limitations that the prior art does not show, as stated in the previous and current Office Actions".

Appellant respectfully submits that the two specific types of "information" and their strategic placement, amount to more than mere ornamentation and present structural limitations that patentably distinguish over the cited art.

The Federal Circuit has clearly stated that the contents of such claimed information must not be ignored and must be considered in determining patentability. More specifically in *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), the Federal Circuit stated that:

[d]ifferences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter (at page 403)

The Court stated further that:

[u]nder Section 103, the Board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole (at page 403)

Of interest in this regard is also the case of *In re Miller*, 418 F.2d 1392, 153 USPQ 46 (CCPA, 1969). *In re Miller* concerned a measuring device having information printed

on the device to allow a user to measure ingredient quantities for fractional recipes, without having to actually compute the fractional quantity necessary. The Patent Office initially rejected the claims as it did not see a structural relationship between the information and the device. The Federal Circuit reversed the Patent Office rejection stating that there was a new and non-obvious functional relationship between the information and the substrate.

As noted above, the significance of Appellant's claimed subject matter relates to the specific type of information and its viewability from different perspectives which allows the headwear piece to function uniquely compared to other headwear pieces. From a front perspective, the identity of the event is prominent, making it useable by the participants; as during a competitive baseball game. From other perspectives, the participants in the event can be identified, making the headwear piece valuable to a fan or souvenir seeker as a memento from the event that identifies participants.

In relying on Kronenberger, the Examiner states only generally that the information as claimed would be obvious. However, Kronenberger does not disclose information with an event and participants and coordinated placement of such information on the front and elsewhere that produces the above results. In fact, Kronenberger does not even teach anything other than a frontal location for all information.

Just as in *In re Miller*, the first and second information as claimed has a new and non-obvious functional relationship with the substrate, the cap. The first and second information is used to educate an observer, identifying an event from one perspective, and the participants in the event from other perspectives. None of the cited references discloses such a functional relationship between headwear shape and information, and

particularly the recited location of information. When given the appropriate patentable weight, claim 1 clearly patentably distinguishes over the cited art.

In conclusion, the relationship of the first and second information, and the effect of its strategic location must be considered. This information amounts to more than ornamentation. The Examiner does not cite any prior art which teaches or makes obvious the structure claimed. One skilled in the art, with Loeffelholz and Kronenberger in hand, would have to rely on Appellant's teachings and use hindsight reconstruction to make modifications thereto to arrive at what is recited in claim 1.

Claim 2

Claim 2 recites a more specific location of the information, whereby the second information can be seen but is not identifiable from a front observation perspective. With this arrangement, the existence of the second information can be determined from the front elevation perspective, however does not significantly take the user's attention away from the first information.

Kronenberger, relied upon for the specific relationship of the information, does not disclose any information corresponding to the second information and its location.

Claim 3

Claim 3 recites the location of the second information as such that it cannot be seen viewing the headwear piece from a front elevation perspective. This arrangement makes the headwear piece more clearly functional as a conventional headwear piece where the

event is prominent and the viewer is not distracted by additional second information from a front elevation perspective view.

Kronenberger, relied upon for the specific placement of information, does not teach or make obvious any corresponding second information at a corresponding location that permits viewing as recited in claim 3.

Claim 18

Claim 18 recites a specific location of the information to achieve the end that the second information does not distract the viewer from attention paid to the first information.

Claims 9 and 10

These claims recite alternative constructions for the crown, which are both known constructions, but which do not exist with the information applied as recited in claim 1, from which these claims depend.

Claim 15

Claim 15 characterizes the second information as defined by embroidery directly on the crown.

While it is well known to embroider information on headwear pieces, it is not known to embroider the specific second information as recited in claim 1, from which claim 15 depends.

Claim 11

Claim 11 characterizes the first information as relating to a non-athletic event. The prior art does not show the coordinated application of corresponding first and second information for any type of event, be it athletic or non-athletic in nature.

Claims 6 and 7

Claim 6 requires that the second information have an identification of each of the participants in the event, with claim 7 characterizing the identifications as logos associated with teams.

By requiring identification of all participants, the headwear piece becomes a valuable and saleable souvenir for a particular event.

Loeffelholz and Kronenberger do not, alone or in any combination, teach or make obvious the inclusion of an identification of all participants in an event that is identified by additional corresponding first information.

Claims 5 and 8

Claims 5 and 8 add another dimension to the utility of the headwear piece. Claim 5 recites third information on the brim/bill related to the event, whereas claim 8 characterizes the third information as identifying one of a plurality of divisions of teams participating in an all star event, identified by the first information. The second information identifies all teams participating in the event.

This construction allows further offering of two different headwear pieces that appeal to those that may be supporting different divisions in an all star event.

While Kronenberger discloses information on a brim/bill, the cited art collectively does not disclose or make obvious the more specific coordination of information as set forth in particularly claim 8.

Claims 12-14

Claims 12-14 recite a specific arrangement of logos, a plurality of which are located in at least one of the octants. Claim 13 recites a skewed arrangement of the logos, whereas claim 14 requires a random orientation of the logos in at least one octant.

The prior art does not teach or make obvious multiple logos in any octant, let alone the specific recitation thereof in these claims.

Claims 16-18

These claims recite a specific distribution of logos that is not taught in or made obvious from the applied art.

Issue No. 2

Claims 19-21

Each of these claims is directed to an adjustable strap at the rear of the headwear piece, with claims 20 and 21 directed to third information on the adjustable strap.

The structure in claims 19-21, by itself, is known in the prior art, but not in combination with the structure in claim 1, from which these claims depend.

Issue No. 3

The Examiner identified in the May 17, 2006 Action, a website with a headwear piece that incorporates the claimed subject matter. The Examiner stated that:

The Examiner feels that the following website shows the claimed invention. (at page 6)

While the Examiner did not specifically state why the product therein was identified, if anything, the product depicted on that site demonstrates copying of the inventive concept, which supports patentability.

Conclusion

It is respectfully submitted that the Examiner's finding of obviousness is based on a failure to give any patentable weight to the specific information claimed and its strategic positioning to afford a uniquely functioning headwear piece. The prior art cited by the Examiner does not teach or make obvious the subject matter of any of the pending claims on appeal. Reversal of the rejection of claims 1-3 and 5-21 is requested.

Respectfully submitted,

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CLAIMS APPENDIX

1. A headwear piece comprising:

a crown comprising an exposed external surface having a front, a rear, a right side, and a left side,

the crown further comprising a surface for embracing a wearer's head to maintain the headwear piece in an operative position on the wearer's head,

the crown having a) a front/right side octant; b) a right side/front octant; c) a right side/rear octant; d) a rear/right side octant; e) a front /left side octant; f) a left side/front octant; g) a left side/rear octant; and h) a rear/left side octant;

a brim/bill projecting forwardly from the crown,

there being no brim/bill projecting from the crown from the left or right side of the crown so that the crown and brim/bill cooperatively are configured as a conventional baseball-style cap,

first information identifying an event on at least one of the front/left side and front/right side octants; and

second information identifying a plurality of participants in the event on at least one of a) the right side/front octant; b) the right side/rear octant; c) the rear/right side octant; d) the left side/front octant; e) the left side/rear octant; and f) the rear/left side octant.

2. The headwear piece according to claim 1 wherein the second information is situated so that the second information can be seen but the second information is not identifiable viewing the headwear piece from a front elevation perspective.

3. The headwear piece according to claim 1 wherein the second information is situated so that the second information cannot be seen viewing the headwear piece from a front elevation perspective.

5. The headwear piece according to claim 1 wherein there is third information on the brim/bill related to the event.

6. The headwear piece according to claim 1 wherein the second information comprises an identification of each of the participants in the event.

7. The headwear piece according to claim 6 wherein the identifications each comprises a logo associated with a team.

8. The headwear piece according to claim 5 wherein the first information identifies an all star event, the third information identifies one of a plurality of divisions of teams participating in the all star event, and the second information comprises an identification of teams participating in the all star event in the one division of teams.

9. The headwear piece according to claim 1 wherein the exposed external surface of the crown extends continuously in an inverted cup shape.

10. The headwear piece according to claim 1 wherein the crown has a top opening through which a wearer's head projects with the headwear piece in the operative position on the wearer's head.

11. The headwear piece according to claim 1 wherein the first information identifies a non-athletic event.
12. The headwear piece according to claim 7 wherein there are a plurality of logos located in at least one of the octants.
13. The headwear piece according to claim 12 wherein a plurality of logos in the at least one octant are skewed from a normal orientation.
14. The headwear piece according to claim 12 wherein the logos are randomly oriented in the at least one octant.
15. The headwear piece according to claim 1 wherein the second information is defined by producing embroidery directly on the crown.
16. The headwear piece according to claim 7 wherein the logos are provided on each of a) the right side/front octant; b) the right side/rear octant; c) the rear/right side octant; d) the left side/front octant; e) the left side/rear octant; and f) the rear/left side octant.
17. The headwear piece according to claim 16 wherein the logos are substantially uniformly distributed on each of a) the right side/front octant; b) the right side/rear octant; c) the rear/right side octant; d) the left side/front octant; e) the left side/rear octant; and f) the rear/left side octant.

18. The headwear piece according to claim 1 wherein the second information is not present on either of the front/right side and front/left side octants.
19. The headwear piece according to claim 1 wherein the crown has a rear opening and an adjustable strap for changing a configuration of the rear opening to thereby alter an effective size of the headwear piece.
20. The headwear piece according to claim 19 wherein there is third information on the adjustable strap.
21. The headwear piece according to claim 20 wherein the third information identifies the event.

EVIDENCE APPENDIX

No evidence submitted.

RELATED PROCEEDINGS APPENDIX

No related proceedings.